

REMARKS

Reconsideration of this application is requested.

Claim 18 is rejected under 35 U.S.C. 102 (b) as being clearly anticipated by Goldschmidt as the reference shows applying torque to a pipe by using a crew to counter rotate two attached sliding jaw wrenches.

Regarding claim 18:

Simply because the cited patent of Goldschmidt has a means for applying torque to a pipe joint by way of a jacking screw does not anticipate applicant's method and apparatus. A 35 U.S. C. 102 rejection requires that each and every element of the claim or an equivalent thereof be present in the cited reference. Examiner has failed to distinctly point out each of the elements (underlined below) of the claimed apparatus as being cited in the Goldschmidt reference.

The cited reference of Goldschmidt fails to disclose a method for applying torque to a threaded pipe joint comprising the step of attaching a portable manual tong assembly to the pipe joint, the tong assembly having an elongated rectangular body member having an elongated slot portion and an elongated lead screw member extending through said slot portion and at least the length of said body member, an upper tong jaw fixed to said body member having a set of opposing sliding pipe dies captured therein and means for positioning at least one of said dies relative to said upper tong jaw and a lower tong jaw having a set of opposing sliding pipe dies captured therein, means for positioning at least one of said dies relative to said lower tong jaw and a slotted arm portion pivotally having an elongated rectangular body member having an elongated slot portion and an elongated lead screw member extending through said slot portion and at least the length of said body member, an upper tong jaw fixed to said body member having a set of opposing sliding pipe dies captured therein and means for positioning at least one of said dies relative to said upper tong jaw and a lower tong jaw having a set of opposing sliding pipe dies captured therein, means for positioning at least one of said dies relative to said lower tong jaw and a slotted arm portion pivotally and translatively attached to a pin assembly threadably traversable along said elongated lead screw member with said pin located within said elongated slot portion of said body member, manipulating said lead screw member thus applying leverage and torque to said lower tong jaw relative to said upper tong jaw via said pipe dies about the axis of said pipe joint.

Even to establish a prima facie case of obviousness, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Courts have also ruled that limitations of the claim including its structural limitations may not be negated. The instant claim must be taken as a whole and not dissected for only the elements found in the cited reference.

Regarding Claim 19

"Claim 19 appears to be a method of making or assembling the device and not a method of applying torque".

Response: Claim 18 recites the structure of the apparatus used to apply torque. Dependent Claim 19 recites the step of adding additional structure in the form of a load cell for obtaining a reading from the applied torque. The load cell is not an essential element of the apparatus and is well known in the art. However, the combination step of attaching such an instrument to this particular apparatus when applying torque and thus observing the degree of torque being applied seems to be more of a method or process of its use than part of the assembly itself.

Inasmuch as each of the rejections have been overcome by the amendment to the claims and through arguments relating thereto, and all of the examiner's suggestions and requirements have been satisfied, it is respectfully requested that the rejections be withdrawn and that this application be passed to issue.

Should the examiner feel that a telephone conference would advance this application, she is encouraged to contact the undersigned at the telephone number listed below.

Please contact the submitter if any fees are due.

Respectfully submitted,



Robert N. Montgomery

Robert N. Montgomery, Reg. No. 35,291

Date: NOV. 5. 2004

109 Brownlee Ave.

Broussard, LA 70518

Telephone: 337-837-4042

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450 Alexandria, VA 22313-1450 on NOV. 15 2004.

Robert N. Montgomery
Robert N. Montgomery,